

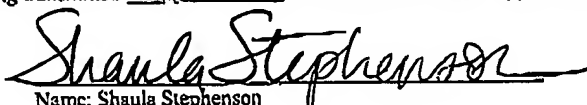
PATENT
Conf. No. 4778

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: William R. Dunn, et al. Examiner: George V. Wang
Serial No. 10/679,977 Group Art Unit: 2871
Filed: October 7, 2003 Docket No. 73538.020500
Title: FLAT PANEL DISPLAY HAVING AN ISOLATED EMI LAYER AND
INTEGRAL HEATER AND THERMAL SENSORS
Customer No.: 33717

CERTIFICATE UNDER 37 CFR 1.6(d)

I hereby certify that this correspondence and identified enclosures are being transmitted via facsimile only to the Board of Patent Appeals and Interferences, Facsimile No. (571) 273-0052 on February 22, 2006.


Name: Shaula Stephenson

REASONS FOR REQUEST FOR PANEL REVIEW

Board of Patent Appeals and Interferences
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Sir/Madam:

Pre-appeal brief conference review is appropriate when there are clear errors in the Examiner's review and/or the Examiner has omitted one or more essential elements needed for a prima facie rejection. Applicants believe that at least one of these conditions is present here.

Claims 2, 4-10, 12-14 and 16-20 are pending in the application, claims 1, 3, 11 and 15 having been cancelled during prosecution. Claim 12 is the sole independent claim in this application.

The Examiner rejected the single independent claim 12 as anticipated by U.S. Patent No. 6,885,412 to Ohnishi, et al. (Ohnishi), fundamentally asserting that since Ohnishi discloses a flat panel display having a metal oxide heater layer, specifically "ITO." The Examiner stated that

Serial No. 10/679,977

PATENT
Docket No. 73538.020500

this disclosure broadly anticipates a flat panel display having a metal heater layer integral to the TFT array layer. Applicants assert that this is clear error by the Examiner.

In the Final Office Action, the Examiner stated that Ohnishi, in Figure 3, ref. 8, shows "a metal layer integral to the TFT array layer." O.A., page 3, lines 4-5. In response, Applicants pointed out that Figure 3, ref. 8 is a metal oxide heater film layer, specifically a ITO metal oxide layer, not a metal layer. Ohnishi col. 9, lines 7-13 states that the ref. 8 is a light-transmissive temperature application section made of a metal oxide. Response After Final, pages 1 and 2. Applicants further pointed out that the Examiner failed to provide any support his assertion in any way. Response After Final, page 2, lines 9-10.

In the Examiner's Advisory Action, he states:

"Applicant's argument is that metal is not the same as a metal oxide both 'chemically and electrically'. However true that may be, the fact that the claims are not clear in specifying or distinguishing a metal from a metal oxide layer makes it possible to reject the recited 'metal' layer with the 'metal oxide' layer of Ohnishi."

It is respectfully submitted that Applicants' claim language is quite clear and that the Examiner's interpretation is without foundation and is thus clearly in error. A metal oxide layer is simply not inclusive of a metal layer. The Examiner failed to provide any support for his asserted position that a metal oxide layer broadly encompasses a metal heater layer.

Although Applicants believed additional support for their position regarding the plain meaning of claim terms was unnecessary, Applicants further submitted a Supplemental Response, after receipt of the Advisory Action, that included three references from the Internet that demonstrated that the material referred to commercially as ITO, and referred to as such in Ohnishi, as indium tin oxide is 91 mol% indium oxide (In_2O_3), with 9 mol% tin oxide (SnO_2), also referred to as tin (IV) oxide, or 90 wt% indium oxide with 10 wt% tin oxide. One reference refers to this as "tin-doped indium oxide." Applicants further stated:

Serial No. 10/679,977

PATENT
Docket No. 73538.020500

“Metals are not transparent, although metal oxides can be. Please refer to *Principles of Materials Science and Engineering*, 3rd edition, by William F. Smith, page 837, a copy of which is also attached. Referring to ‘metals,’ Professor Smith states that ‘except for very thin sections, metals strongly reflect and/or absorb incident radiation’ and that ‘this type of action results in strongly reflected beams of light from a smooth surface.’ Thus, Applicants urge the Examiner to reconsider his rejection, based on the plain meaning of the term ‘metal’ to one of ordinary skill and its distinction from ‘metal oxide.’”

The Examiner provides no support for his position interpreting “metal oxide” as encompassing “metal” in the Final Office Action and the Advisory Action, which is clearly contrary to common knowledge in the art.

The Examiner further rejected dependent claims 2, 4-9, and 16-17 under 35 USC 103 over Ohnishi in view of combinations of Shin, et al. and Muhlemann. Neither of these additional references disclose metal heater layers. Accordingly they, together with Ohnishi, in any combination, cannot anticipate Applicants’ independent claim 12. For this reason the Examiner’s rejections under both 35 USC 102 and 103 are improper and should be withdrawn. Claim 12 is clearly allowable over the cited prior art. As claims 2, 4-10, 13, 14 and 16-20 depend from claim 12 these claims are also clearly allowable and such action is earnestly solicited.

The rejection in the Final Office Action for double patenting was addressed in the Supplemental Response. A distinguishing amendment was filed in the copending application thus obviating the double patenting rejection.

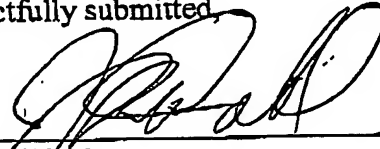
It is respectfully submitted that the Examiner’s rejections in the Final Office Action and his position in the Advisory Action is clearly erroneous and that the application is in condition for allowance.

Serial No. 10/679,977

PATENT
Docket No. 73538.020500

The Director is authorized to charge \$500.00 in fees for the filing of a Notice of Appeal, as well as any additional fee(s) or any underpayment of fee(s), or to credit any overpayments to **Deposit Account Number 50-2638**. Please ensure that Attorney Docket Number 73538.020500 is referred to when charging any payments or credits for this case.

Respectfully submitted,



John R. Wahl
Reg. No. 33,044

Date: February 22, 2006

Customer Number 33717
GREENBERG TRAURIG, LLP
2450 Colorado Avenue, Suite 400E
Santa Monica, CA 90404
Phone: (310) 586-6541
Fax: (310) 586-0541
E-mail: wahlj@gtlaw.com

LA-FS1\389856v01

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x, OMB 0651-00xx

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

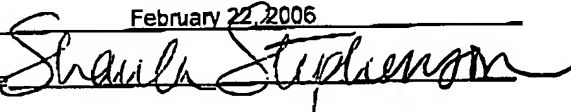
Docket Number (Optional)

73538-020502

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on February 22, 2006

Signature

Typed or printed
name

Shaula Stephenson

Application Number

10/679,977

Filed

October 7, 2003

First Named Inventor

William R. Dunn, et al.

Art Unit
2871Examiner
George V. Wang

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

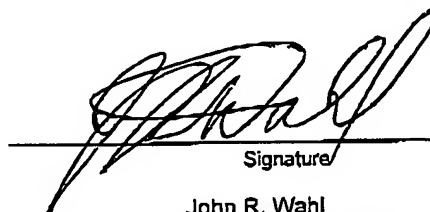
☒

attorney or agent of record.

Registration number 33,044☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____



Signature

John R. Wahl

Typed or printed name

(310) 586-6541

Telephone number

February 22, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below.

☒*Total of 2 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.